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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,593	07/19/2006	Masataka Nakahara	4605-062147	1650

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,593	Applicant(s) NAKAHARA ET AL.	
	Examiner Michael A. Marcheschi	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/2/08</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election of Group II, claims 5-15 in the reply filed on 3/6/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 14 are indefinite as to the limitation "powder form is within 20 microns" because the examiner is unclear as to the metes and bounds of this limitation. Is the size of the powder (1) 20 microns, (2) approximately 20 microns or (3) are applicants implying a range (i.e. the use of the term "within" would be implying range although none is defined) . In addition, the powder is within 20 microns of what.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 11-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ryoke et al. (789).

The reference teaches in the abstract, column 4, lines 8-31, column 5, line 10-column 6, line 67 and column 10, line 31-35, a polishing film comprising a substrate and an abrasive layer thereon, wherein the abrasive layer comprises (1) a binder (polyester) which is cross-linked with isocyanates, (2) abrasives and (3) 0.01-30 weight percent of a powdered material (i.e. EDTA-claimed material that being ethylenediaminetetraacetic acid)). The thickness of the abrasive layer is defined as being 1-100 microns. It is to be noted that a polishing film is inherently used to polish an object.

The claimed invention is anticipated by the reference because the reference teaches a polishing film which comprises all of the claimed components along with the claimed specific structural aspects of the claimed polishing film. The reference adds EDTA in an amount of 0.01-30 weight percent and this reads on the claimed pH adjustor, since the material used is the same, irrespective of what it is called or used for.

With respect to the limitations defined in last three lines of claim 1 (i.e. a polishing fluid being...to be polished), it is to be noted that the instant claims are directed to a polishing film and

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not a polishing system, thus the above limitations are deemed to be functional characteristics of the film itself when put into the defined intended use and such functional limitations are not seen to further define (1) over the reference because the reference is a polishing film and it is capable of polishing an object and (2) the above limitations do not further define the structural aspects of the polishing film, as claimed.

Assuming *arguendo*, since the reference uses the same material as the claimed pH adjustor and the balance of the film is the same, it is reasonably expected and thus *prima facie* obvious that the pH adjustment of a polishing fluid will take place absent clear evidence otherwise. In addition, it is examiners position that the functional characteristics defined in last three lines of claim 1 are expected and thus obvious parameters when the polishing film of the reference is used to polish an object absent specific evidence otherwise (i.e. how the claimed polishing film differs from the reference polishing film).

Claims 8-10 and 13-15 are rejected under 35 U.S.C. 103(a) as obvious over Ryoke et al. (789).

With respect to claim 8, the reference teaches an amount for the EDTA which overlaps the claimed amount and thus the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976).

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With respect to claims 9-10 and 13-15 (claim 15 depends on claim 13), although the reference does not specifically define the size of the powder, it is to be noted that this reference does teach that EDTA powder can be used and this coupled with the thickness of the abrasive layer, that being 1-100 microns, would clearly imply that the size of the powder must be less than the size of the upper thickness limit of the film because, if not, the defined thickness of the reference would not be obtained (i.e. particles larger than 100 um would not provide a thickness of 100 microns or less). In view of this, one skilled in the art would have appreciated that the size of the powder must be less than 100 microns and therefore the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, **182 U.S.P.Q. 549**; *In re Wertheim* **191 USPQ 90 (CCPA 1976)**. If applicants disagree they are requested to submit clear proof otherwise (i.e. that a powder of the reference would not fall within the claimed range).

The references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any foreign language documents submitted by applicant has been considered only to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793